

ESTTA Tracking number: **ESTTA501729**

Filing date: **10/24/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Kiko, S.R.L.		
Entity	Corporation	Citizenship	Italy
Address	Via Giorgio Paglia, 1/D Bergamo, 24122 ITALY		

Attorney information	Michael J. Leonard Panitch Schwarze Belisario & Nadel LLP 2005 Market Street - Suite 2200 Philadelphia, PA 19103 UNITED STATES usptotm@panitchlaw.com, mleonard@panitchlaw.com
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Applicant Information

Application No	79105543	Publication date	09/25/2012
Opposition Filing Date	10/24/2012	Opposition Period Ends	10/25/2012
International Registration No.	1097704	International Registration Date	10/31/2011
Applicant	Shang Hai Hui Zhong Fashion Co., Ltd No. 5008, Zhen Nan Road Shanghai City CHINA		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Clothing, namely, shirts, pants, coats, dresses, hats, shoes

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Upon information and belief, Applicant lacks a bona fide intent to use the mark in United States commerce.



Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1837925	Application Date	08/10/1989
Registration Date	05/31/1994	Foreign Priority Date	NONE

Word Mark	KIKO
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1985/04/09 First Use In Commerce: 1985/05/22 APPAREL AND CLOTHING; NAMELY, BLOUSES, SHIRTS, TANK TOPS, SHORTS, PANTS, SKIRTS, DRESSES, JACKETS, TRENCH COATS, COATS, SWEATERS, SCARVES AND BELTS

U.S. Registration No.	1991440	Application Date	09/22/1995
Registration Date	08/06/1996	Foreign Priority Date	NONE
Word Mark	KIKO COMFORTABLE CLOTHING		
Design Mark	 <p>The design mark features the word "Kiko" in a large, bold, black, handwritten-style font. Below it, the words "COMFORTABLE CLOTHING" are written in a smaller, black, all-caps, sans-serif font.</p>		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1985/04/09 First Use In Commerce: 1985/05/22 apparel and clothing, namely blouses, shirts, tank tops, shorts, pants, skirts, dresses, jackets, trench coats, coats, sweaters, scarves and belts		

U.S. Registration No.	3356878	Application Date	10/13/2006
Registration Date	12/18/2007	Foreign Priority Date	NONE
Word Mark	KIKO BAY		
Design Mark	 <p>The design mark features the words "KIKO BAY" in a large, black, all-caps, serif font.</p>		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2007/03/02 First Use In Commerce: 2007/03/02 Apparel and clothing, namely, blouses, shirts, tank tops, shorts, pants, skirts,		

	dresses, jackets, trench coats, sweaters and scarves		
U.S. Registration No.	3689438	Application Date	06/01/2005
Registration Date	09/29/2009	Foreign Priority Date	NONE
Word Mark	KIKO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: Perfumes, toilet soaps, cosmetics, namely deodorants for personal use; creams, lotions and oils for the face and body; skin cleansing milks, creams and oils; make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara, rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams, oils and lotions; pre and after shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes		
U.S. Registration No.	3650052	Application Date	09/23/2008
Registration Date	07/07/2009	Foreign Priority Date	NONE
Word Mark	KIKO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: Make-up for women		
U.S. Registration No.	4065381	Application Date	04/27/2010

Registration Date	12/06/2011	Foreign Priority Date	11/16/2009
Word Mark	KIKO		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: Spectacles, cases and chains for spectacles, frames for spectacles, optical lenses</p> <p>Class 014. First use: Jewellery and costume jewellery, namely rings, bracelets, necklaces, tie-bars, scarf rings, pendants, ear clips, tie clips, cufflinks, earrings, key holders made of precious metals, brooches, pins being jewelry; clocks, watches, chronographs for use as watches, chronometers</p>		

Attachments	74733321#TMSN.gif (1 page)(bytes) 77020737#TMSN.jpeg (1 page)(bytes) 78641087#TMSN.jpeg (1 page)(bytes) 77576761#TMSN.jpeg (1 page)(bytes) 79095635#TMSN.jpeg (1 page)(bytes) 00458132.PDF (6 pages)(218006 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/michael leonard/
Name	Michael J. Leonard
Date	10/24/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RE: U.S. Trademark Application Serial No. 79/105,543
Published in the Official Gazette on 25 September 2012

KIKO, S.R.L.)	
)	
Opposer)	
)	Opposition No. _____
-v-)	
)	
SHANG HAI HUI ZHONG)	
FASHION CO., LTD.)	
)	
Applicant)	
)	
)	
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NOTICE OF OPPOSITION

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22314

Commissioner:

In the matter of Application Serial No. 79/105,543 filed 31 October 2011 by Shang Hai Hui Zhong Fashion Co., Ltd (“Applicant”), to register the mark KAKO and Design for goods described as "clothing, namely, shirts, pants, coats, dresses, hats, shoes" in International Class 25 (“Applicant’s Goods”), which was published in the Official Gazette on 25 September 2012, Kiko S.r.L. (“Opposer”) of Bergamo, Italy, believes it will be damaged by the registration of the KAKO and Design mark and opposes same. The grounds for this opposition are as follows:

1. Upon information and belief, Applicant is a Chinese Limited Liability Company having an address in Shanghai City, China. On 31 October 2011, Applicant filed an International Application designating the United States. The United States Designation, later assigned Application Serial No. 79/105,543, sought registration in the United States based on Applicant's ownership of International Registration No. 1097704 and an alleged bona fide intent to use the KAKO and Design mark in United States commerce.

2. Opposer is the owner, by assignment, of incontestable U.S. Trademark Registration No. 1,837,925 for KIKO issued 31 May 1994 and covering goods described as "apparel and clothing, namely, blouses, shirts, tank tops, shorts, pants, skirts, dresses, jackets, trench coats, coats, sweaters, scarves and belts" ("Opposer's Goods"). Opposer is also the owner of U.S. Trademark Registration No. 1,991,440 for the mark KIKO COMFORTABLE CLOTHING (stylized) and U.S. Trademark Registration No. 3,356,878 for the mark KIKO BAY, both covering various goods in International Class 25.

3. Opposer is the owner, by assignment, of U.S. Registration No. 3,689,438 for KIKO covering "perfumes, toilet soaps, cosmetics, namely deodorants for personal use; creams, lotions and oils for the face and body; skin cleansing milks, creams and oils; make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara, rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams; oils and lotions; pre and after shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes." Opposer is also the record owner of U.S. Registration No. 3,650,052 for KIKO covering "make-up for women;" and U.S. Registration No. 4,065,381 for "spectacles, cases and chains for spectacles, frames for spectacles, optical lenses;" in Class 9 and "Jewellery and costume jewellery, namely rings,

bracelets, necklaces, tie-bars, scarf rings, pendants, ear clips, tie clips, cufflinks, earrings, key holders made of precious metals, brooches, pins being jewelry; clocks, watches, chronographs for use as watches, chronometers;” in Class 14.

4. Opposer’s Registrations are not limited by channels of trade or classes of purchasers. Opposer’s Registrations are valid, subsisting and are *prima facie* evidence of the validity of each registered Mark set forth therein, the registration of each registered Mark set forth therein, and Opposer’s exclusive right to use each registered Mark set forth therein in connection with the Goods specified in the Registrations.

5. Commencing prior to Applicant’s filing date and any alleged date of first use that can be claimed by Applicant, Opposer’s KIKO Mark became registered covering clothing and apparel.

6. Since the initial use and registration of the KIKO Mark, Opposer’s Goods have been advertised, promoted and sold under the KIKO Mark. Opposer’s customers and the public in general have come to know and recognize Opposer’s KIKO Mark and associate the Mark with Opposer and/or Opposer’s Goods.

7. Applicant’s KAKO and Design mark is confusingly similar to Opposer’s previously used and registered KIKO Mark and applies to substantially similar, and in some cases identical, goods to those covered by Opposer’s KIKO Registrations and is likely, when used in connection with Applicant’s Goods, to cause confusion or mistake or to deceive purchasers resulting in damage to Opposer and its reputation.

8. Opposer’s Goods and Applicant’s Goods, which are substantially similar, and in some cases identical, are likely to be offered and sold through the same channels of trade and purchased by the same class of purchasers.

9. Opposer's customers, and the public in general, are likely to be confused, mistaken, or deceived as to the origin, affiliation, endorsement or sponsorship of Applicant's Goods sold and marketed under Applicant's KAKO and Design mark and misled into believing that such goods are produced by, offered by, sold by, emanate from or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

10. Applicant's 31 October 2011 filing date of Application Serial No. 79/105,543 is subsequent to Opposer's 9 April 1985 date of first use of its KIKO Mark and to the filing dates of Opposer's pleaded registrations.

11. Applicant's filing of Application Serial No. 79/105,543 for KAKO and Design is without license, authorization or permission from Opposer.

12. Upon information and belief, Applicant does not possess the requisite bona fide intent to use its KAKO and Design mark on or in connection with all of the goods set forth in Application Serial No. 79/105,543.

13. Opposer will be damaged by the registration of the KAKO and Design mark as set forth in Application Serial No. 79/105,543, in that the mark is confusingly similar to Opposer's KIKO Mark, thereby violating Opposer's rights to its Mark.

14. Registration of Applicant's KAKO and Design mark should not be granted as it is contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its KIKO Mark.


WHEREFORE, Opposer prays that its Opposition be sustained, that Application Serial No. 79/105,543 be refused and that the registration of KAKO and Design as a trademark to Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

KIKO S.r.L.

Date: 24 Oct. 2012

By:



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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Notice of Opposition was served on Applicant's counsel this 24th day of October 2012 by sending same via U.S. Airmail, postage prepaid, and e-mail to:

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